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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO.   |
|--|-------------|----------------------|---------------------|--------------------|
| 10/038,290   | 10/19/2001  | Gregory A. Hyatt     | 5203-65             | 6716               |
| 24256  | 7590        | 06/03/2005           |                     |                    |
| DINSMORE & SHOHL, LLP<br>1900 CHEMED CENTER<br>255 EAST FIFTH STREET<br>CINCINNATI, OH 45202 |             |                      | EXAMINER            | RACHUBA, MAURINA T |
|  |             |                      | ART UNIT            | PAPER NUMBER       |
|  |             |                      | 3723                |                    |

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/038,290             | HYATT, GREGORY A.   |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | M Rachuba              | 3723                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 May 2005.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) 2-5,10,11 and 13-19 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,6-9,12,20-24 and 26-34 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 June 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 2-5, 10, 11, and 13-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

***Response to Amendment***

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Please see paragraph 2 of applicant's response filed 11 May 2005.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 6-9, 12, 21-24, 26, 29, 30 and 34 are finally rejected under 35 U.S.C. 102(b) as being clearly anticipated by Grage, 3,110,993. Please refer to figures 1-3 and their descriptions. Note that openings 16 meet the limitations of claim 8.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grage, '993. '993 discloses that the tool is abrasive. The examiner takes Official notice that the selection of abrasive material depends on the material being abraded or machined, and use of superabrasive, such as cubic boron nitride (CBN), diamond or polycrystalline products to machine hard materials is old and well known in the abrasive tool art. One of ordinary skill would have considered it obvious to have provided '933 with a superabrasive, dependent on the type of material to be machined.

7. Claims 20, 27, 28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grage, '993 in view of Wohlmuth, 4,438,598. "993 discloses the claimed invention except for the fluid delivery system adapted to compensate for changes in material characteristics of the tool to assist in maintaining proper dispersal of fluid at a machining zone. '598, figure 1, teaches providing a deliver system which is adapted to compensate for changes in temperature of the tool to maintain proper dispersal of fluid at the machining zone. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided '993 with the control system of '598, to ensure that hardness, wear-life, appearance and contour of the workpiece and/or tool are not impaired by improperly controlled temperatures.

Regarding claim 28, '598 teaches that it is known to provide coolant to a tool that uses the peripheral face to process the workpiece, and that any other type of abrasive tool may be used. It would have been obvious to one of ordinary skill to have provided '993

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with a tool that uses the peripheral face, as taught by '598, to allow grinding of other surfaces other than flat.

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1, 6-9, 12, 20-24, and 26-31 have been considered but are not persuasive. Applicant argues that '993 does not disclose a tool having an outer surface disposed about the rotational axis, meaning the outer peripheral surface, as disclosed by applicant's specification. It is noted that the features upon which applicant relies (i.e., the peripheral surface of the tool) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Here, '993 does disclose an outer radial surface that is disposed about the rotational axis of the tool. Further, applicant's reliance of the specification to teach that the contact location of the fluid may be adjusted to compensate for changes in the material characteristics of the tool is not convincing. Again, limitations from the specification cannot be read into the claims. Applicant may overcome the rejection under 35 USC 102 by claiming the disclosed invention.

#### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Rachuba whose telephone number is **(571) 272-4493**. The examiner can normally be reached on Monday-Thursday from 8:30 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail, can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Rachuba  
Primary Patent Examiner



6/1/05

A handwritten signature of "M. Rachuba" is written in cursive ink. To the right of the signature, the date "6/1/05" is handwritten vertically.